

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

HEADWATER RESEARCH LLC,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD and
SAMSUNG ELECTRONICS AMERICA, INC.,

Defendants.

Case No. 2:23-cv-00641-JRG-RSP

JURY TRIAL DEMANDED

**DEFENDANTS' NOTICE OF IMMINENT MOTION TO DISMISS *INTER PARTES*
REVIEW OF U.S. PATENT NO. 8,639,811 FOLLOWING HEADWATER'S MAY 30,
2025 DISMISSAL OF THE '811 PATENT AND IMPACT ON
PENDING MOTION TO STAY (DKT. 96)**

Defendants Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively "Samsung"), by and through their undersigned counsel, respectfully notify the Court that, pursuant to an executed agreement between Samsung and plaintiff Headwater Research LLC ("Headwater"), the parties (1) have jointly moved to dismiss U.S. Patent No. 8,639,811 (the "'811 patent") from this case (Dkt. 131), and (2) will imminently move to dismiss *inter partes* review ("IPR") No. IPR2024-01051. IPR2024-01051 is an instituted IPR proceeding challenging the validity of claims 1–30 of the '811 patent.

After the Patent Trial and Appeal Board ("PTAB") instituted IPRs challenging all patents asserted in this case, Samsung filed Defendants' Motion to Stay Pending *Inter Partes* Review of All Asserted Patents (the "Motion to Stay"). Dkt. 96. The Motion to Stay was fully briefed on April 25, 2025. Dkt. 112. A few days later, counsel for Samsung wrote counsel for Headwater and reiterated that the PTAB will cancel the claims of the '811 patent, particularly in light of Headwater's election to not file a Patent Owner's Response in IPR2024-01051. Ex. A. Then, on

May 3, 2025, Headwater agreed in principle to dismiss the '811 patent from this case. Ex. B. The parties subsequently executed a written agreement, and they jointly moved to dismiss the '811 patent on May 30, 2025. Dkt. 131.

In view of the joint motion to dismiss the '811 patent from this case and the imminent joint motion to dismiss IPR2024-01051, the aspects of the Motion to Stay specifically concerning IPR2024-01051 and the '811 patent are now moot. In light of the fact that the IPRs relating to the three remaining patents in this case have all been instituted by the PTAB, Samsung submits the narrowing of the patents and issues at the PTAB and in this court further supports its Motion to Stay.

Samsung also respectfully notifies the Court that it is prepared to argue the Motion to Stay on June 18, 2025, if oral argument would aid the Court.

Dated: June 3, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on June 3, 2025. As of this date, all counsel of record had consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A).

/s/ Michael J. McKeon

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